

REMARKS

The Amendments

Support for the new dependent claims is found, for example, at page 5, lines 27-29; page 5, lines 33-34; page 6, line 27; page 7, lines 5-6; page 7, lines 17-24.

The amendments do not narrow the scope of the claims and/or were not made for reasons related to patentability. The amendments should not be interpreted as an acquiescence to any objection or rejection made in this application.

To the extent that the amendments avoid the prior art or for other reasons related to patentability, competitors are warned that the amendments are not intended to and do not limit the scope of equivalents which may be asserted on subject matter outside the literal scope of any patented claims but not anticipated or rendered obvious by the prior art or otherwise unpatentable to applicants. Applicants reserve the right to file one or more continuing and/or divisional applications directed to any subject matter disclosed in the application which has been canceled by any of the above amendments.

The First Rejection under 35 U.S.C. §103

The rejection of claims 10, 11, 13-15, 17-20 and 22-24 under 35 U.S.C. §103, as being obvious over WO 98/38253 in view of Vanderhoff (U.S. Patent No. 5,830,927) and EP 528,602 is respectfully traversed.

Hechler (U.S. Patent No. 6,398,862) corresponds to WO 98/38253 and, since it is in the English-language, will be referred to herein for addressing WO 98/38253. Hechler discloses non-dusting pigment preparations having at least 40% by weight of pearl luster pigments. The pigment compositions further contain a surface-active agent and an organic

polymer; see, e.g., col. 2, lines 2-10. The organic polymers contemplated by the reference are thickeners, dispersants and/or binder resins. There is no mention or suggestion of a styrene-modified polyacrylate polymer, particularly not one having an acid number > 90 mg KOH/g.

The Vanderhoff and EP '602 references are cited in the Office Action as suggesting modification of Hechler to provide a styrene-modified polyacrylate polymer having an acid number > 90 mg KOH/g in the Hechler compositions. Particularly, it is alleged that the secondary references teach that such a styrene-modified polyacrylate polymer is known as a pigment stabilizer and that one of ordinary skill in the art would have been motivated to use a pigment stabilizer in the Hechler composition. Applicants respectfully disagree that one of ordinary skill in the art would have been motivated to combine the references in the manner set forth in the Office Action or that such combination would suggest the claimed invention to one of ordinary skill in the art.

Vanderhoff is directed to printing ink compositions, particularly, UV-curable compositions which are solvent-free for gravure and flexographic printing on hydrophobic surfaces; see, e.g., col. 1, lines 1-19; and col. 3, lines 25-30. The compositions contain a low MW hydrophobic, UV-curable vinyl polymer binder which is emulsified, a water insoluble pigment which is ground with a water soluble polymeric grinding vehicle, and a thickener; see, e.g., claim 1. As the water soluble polymeric grinding vehicle, Vanderhoff generally discusses copolymers of a carboxyl-containing monomer with a styrene (see, e.g., col. 8, lines 17-22) and styrene/acrylic resins are used in the Examples (see, e.g., col. 12, lines 38-51).

There is no suggestion in the references as to why one of ordinary skill in the art would be motivated to use the polymeric grinding vehicle styrene/acrylic resins of Vanderhoff in the Hechler compositions. Hechler discloses no need for the grinding or

emulsifying of any of its components and no other reason is apparent why one of ordinary skill in the art would be motivated to use a grinding vehicle in the Hechler compositions. Contrary to the statement in the Office Action, applicants see no disclosure in Vanderhoff that its styrene/acrylic resins are stabilizers for pigments. Nor do applicants see any teaching in Hechler that a stabilizer for the pigments is desired therein. Additionally, the emulsified printing ink compositions of Vanderhoff are very different in their make-up and their use from the Hechler flowable powder or paste pigment compositions. No nexus is seen as to why one of ordinary skill in the art would modify the Hechler compositions by taking the styrene/acrylic resin component of Vanderhoff and incorporating it into the Hechler compositions. No supporting teachings of the references are provided to make such a modification.

Also, even if the styrene/acrylic resin component of Vanderhoff were incorporated into the Hechler compositions, there is no teaching in Vanderhoff that its styrene/acrylic resin component has an acid number > 90 mg KOH/g. Thus, even if the combination was made, all elements of the claimed invention would not be met.

EP '602 teaches coating colored organic pigments with a vinyl polymer. Included among the many possible vinyl polymers (see, e.g., page 2, lines 19-24) are acrylic polymers which can be copolymerized with ethylenically unsaturated monomers, such as styrene. The reference teaches that the polymer coating improves the storage stability of the colored organic pigment.

As with Vanderhoff, no teachings in the references motivate one of ordinary skill in the art to use the vinyl polymer coating of EP '602 on the pigments of Hechler. The Hechler pigments are not colored organic pigments. All the Hechler pigments are inorganic pigments, particularly pearl luster pigments based on platelet-shaped substrates. The Hechler pigments

are quite distinct from the pigments treated according to EP '602; compare page 4, lines 34-37 of EP '602. There is no suggestion that one of ordinary skill in the art would expect that the polymer coating of EP '602 would be useful on the Hechler inorganic pigments or that there would be any desire to coat the Hechler inorganic pigments in this manner. Further, there is no teaching in Hechler that such a coating is desired or that any coating for improving storage stability is desired.

Additionally, even if the combination were made, there is no teaching in EP '602 that its vinyl polymers have an acid number > 90 mg KOH/g. Thus, even if the combination were made, all elements of the claimed invention would not be met.

For all of the above reasons, it is urged that the art does not provide the necessary motivation to combine the references in the manner set forth in the Office Action and, regardless, even if such combination is made, the claimed invention is not met thereby. Thus, the rejection under 35 U.S.C. §103 of the claims over Hechler in view of Vanderhoff and EP '602 should be withdrawn.

The Second Rejection under 35 U.S.C. §103

The rejection of claims 10-24 under 35 U.S.C. §103, as being obvious over WO 98/38253 in view of Vanderhoff and EP 528,602 and further in view of Mead U.S. Patent No. 5,596,027) and Bellas (U.S. Patent No. 5,897,698) is respectfully traversed.

The arguments made above regarding Hechler, Vanderhoff and EP '602 are referred to and incorporated by reference herein. These references do not support the underlying basis of this rejection for those same reasons. Thus, the rejection should be withdrawn at least for this reason.

The additional Mead and Bellas references do not solve the deficiencies of the

primary references discussed above. As with the primary references, neither Mead or Bellas provide any teachings which would motivate one of ordinary skill in the art to combine a styrene-modified polyacrylate having an acid number > 90 mg KOH/g into the Hechler compositions.

Mead is directed to ink jet compositions having a number of components, one of which is an acidic polymer including among other possibilities, styrene acrylate copolymers. The colorant (see, e.g., col. 7-9) is not of the type of pigment used in the Hechler compositions. Thus, analogous to the discussion of EP '602, there is no motivation to use the Mead polymer in the Hechler compositions.

Bellas discloses pearl luster-type pigments but, like Hechler, provides no suggestion or motivation to include a styrene-modified polyacrylate having an acid number > 90 mg KOH/g therein.

There are also no teachings to motivate use of the Mead polymer together with the Bellas pigment. References can only be combined where there is some motivation for one of ordinary skill in the art to do so. Such motivation cannot derive merely from an attempt to piece the references together to arrive at the claimed invention. As stated in In re Wesslau, 147 USPQ 391 (CCPA 1965):

... it is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art.

Accordingly, this rejection under 35 U.S.C. §103 should also be withdrawn.

The Third Rejection under 35 U.S.C. §103

The rejection of claims 10-13 and 18 under 35 U.S.C. §103, as being obvious over Vanderhoff in view of Bellas is respectfully traversed.

The discussions of Vanderhoff and Bellas above are referred to and incorporated by reference herein.

Again, applicants strongly urge that no motivation exist to combine the Vanderhoff polymer into pigment compositions of Bellas. The Office Action alleges that such combination would be an obvious design choice. Applicants fail to see why it would be an obvious design choice to use a polymer taught as a grinding vehicle in the Bellas compositions. There is nothing to suggest to one of ordinary skill in the art that there would be any desire to provide a grinding vehicle in the Bellas compositions. In order to establish obviousness under 35 U.S.C. §103, the mere fact that the prior art could be modified to arrive at the claimed invention is insufficient. The prior art must suggest to one of ordinary skill in the art the desirability of the necessary modification. See In re Laskowski, 10 USPQ2d 1397 (Fed. Cir. 1989); and, In re Geiger, 2 USPQ2d 1276 (Fed. Cir. 1987). There is no such suggestion from the prior art here.

The Fourth Rejection under 35 U.S.C. §103

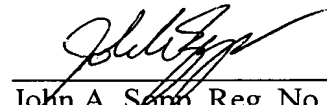
The rejection of claims 10-18 under 35 U.S.C. §103, as being obvious over Vanderhoff in view of Bellas further in view of Mead is respectfully traversed.

The discussions of Vanderhoff, Bellas and Mead above are referred to and incorporated by reference herein. For all of the reasons already discussed, the addition of Mead also provides no teachings to suggest combining a styrene-modified polyacrylate having an acid number > 90 mg KOH/g into a pigment composition of Bellas or Hechler. Thus, this rejection is also not supported by the cited references and should be withdrawn.

It is submitted that the claims are in condition for allowance. However, the Examiner is kindly invited to contact the undersigned to discuss any unresolved matters.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,



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